

REMARKS

A. Introduction

Claims 1-9, 21-22, and 24-33 were pending and under consideration in the application, claims 10-20 and 23 having been previously canceled.

In the Office Action dated November 10, 2010, claims 1-9, 21-22, and 24-33 were rejected under 35 U.S. C. §103(a) as allegedly being unpatentable over Boushy et al., U.S. Patent No. 6,003,013 (hereinafter, "*Boushy*") in view of Pierce, U.S. Patent No. 6,332,126 (hereinafter, "*Pierce*"), and Walker U.S. Patent Publication No. 2003/0027635 (hereinafter, "*Walker*").

In response, Applicants are hereby amending the claims for clarity. Support for the amendment may be found, at least in paragraph 0131, 0176, and 0178 of the application as published as US Pat. Pub. 2004/0143496. No new matter is being added.

B. Rejections under 35 U.S.C. §103

Claims 1-9, 21-22, and 24-33 were rejected as allegedly being unpatentable over *Boushy* in view of *Pierce* and *Walker*.

Boushy relates to techniques for tracking customers' gaming and non-gaming activity across affiliated casino properties, for use in customer recognition and marketing programs, whereby customers are differentiated according to their worth to the casino. Customer information is accumulated at each affiliated casino through one or more LAN-based management systems, updated to a central patron database (CPDB) that is coupled to each casino LAN through a WAN, and made available to each affiliated casino property as needed. Customer accounts are automatically activated and provided with data from the CPDB when a customer from one casino property first visits an affiliated casino property. Customer accounts are updated with status information based on the customer's worth to the casino. Customer accounts are updated with new activity data whenever a management system associated with the casino receives customer data from input devices, such as card readers, workstations, and dumb terminals, located at various venues throughout the casino. Customers are awarded points, based on their tracked activity at all affiliated casino properties. Customers also have theoretical win profiles. Customer status may be based on accumulated points or the theoretical win profile.

When the customer is recognized at a gaming machine, or any location having a suitable card reader, the customer's status is determined in the customer account. For a special status customer, a physical instrumentality is activated for the benefit of the customer, such as a telephone, light, lockable cabinet, or the like. Distinguished services may also be provided once the special status customer is recognized. *Boushy*, abstract.

As acknowledged by the Office Action (pages 4 and 6), *Boushy* fails to disclose a hand-held display device, the use of which is limited to operators of the gaming establishment, with a first interface and a second interface on the display device, wherein said first interface comprises a visual indicator to display a location of a first patron rendered on the floor diagram of a gaming establishment wherein and said second interface displays information indicating at least one recommendation of an award to offer to the first patron, the at least one recommendation of an award resulting from generating a profile for said first patron, matching two or more awards to said profile, determining for each of the awards a likelihood of acceptance by said first patron and sorting the two or more awards according to the likelihoods of acceptance.

The Office Action, in attempting to cure the foregoing acknowledged deficiencies in *Boushy*, relied on subject matter taken from *Pierce* and *Walker*. This reliance is misplaced, because these references, taken as a whole, are mutually incompatible. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP 2141.02 VI, emphasis in original, citing *W. L. Gore & Associates, Inc., v. Garlock, Inc.*, 721 F. 2d 1540 (Fed. Cir. 1983), cert. denied 469 U.S. 851 (1984). "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP 2143.01(V). Only with the hindsight benefit of Applicants' teachings would a person of ordinary skill in the art endeavor to select and combine disparate elements of each reference in the manner proposed by the Office Action.

Pierce relates to a computer based targeted payment system discount program, where consumer information *from consumer payment system institutions* is used to match qualified consumers to targeted merchant discount offers. *Pierce*, abstract. An object of *Pierce* is to "meet the objectives of merchants ... and consumers *as well as the financial institutions* on both sides of the interchange." *Merchants* are enabled to provide a large number of interested consumers with value propositions that discount the merchant's products and services, and to

provide consumers, or cardholders, with a ***broad range of merchant offers*** in which they will be most interested. A further object is to “increase the use of the bankcards of ***participating financial institutions***, for implementing targeted discounts ***without the need for coupons, mailings, or additional transactions on the part of either the cardholder or merchant***. *Pierce*, 2:15-29.

Pierce discloses an automated process which matches ***targeted merchant offers*** against a data base of consumers and historical purchase behavior; the automated process matches the value propositions of merchant offers against the consumer data base supplied by the ***participating issuers*** to find eligible consumers. Each consumer receives multiple value propositions ***from different merchants***. *Pierce*, 2:38-3:15.

This prioritization of merchant offers may be altered by the cardholder's issuing financial institution. Issuing institutions may automatically or manually either exclude or preference particular offers for particular cardholders. ***Through an automated process, consumers receive notification of the value propositions available to them***. The redemption of the value propositions is automatic when the consumer uses his or her credit card at the merchant/service providers establishment. *Pierce*, 3:28-3:49

In distinct contrast, *Boushy* discloses various enhanced physical instrumentalities and distinguished services to a customer based on the customer's worth to the casino. Each customer is issued an identity card which is associated with his or her own customer data in a customer database. The card enables the customer to be immediately recognized any time the card is input into a suitable card reading device coupled to the system. An object of *Boushy* is to provide the customer with distinguished services or physical instrumentalities based on the customer's worth to the casino. *Boushy* 2:23-41.

Boushy discloses ***a local area network (LAN) at each affiliated casino property and a wide area network (WAN) for coupling data among the casino LANs***. A management system ***associated with each casino LAN*** receives customer data from card readers, workstations, and dumb terminals, located at various venues throughout the casino and couples the received data to a database that is accessible to all affiliated casino properties. *Boushy* 2:41-50.

In operation, a customer ***presents an identity card to a card reader when initiating a gaming or non-gaming activity***. The system recognizes the customer from the identity card and

obtains customer data of the customer from the CPDB or from a local database, including data indicating the customer's status. *Boushy* 3:4-8.

According to *Boushy*, ***enhanced physical instrumentalities are provided to the customer based on the customer's status***. For example, when a valuable customer is recognized at a slot machine, a highly visible light on top of the slot machine may be activated, thereby alerting both casino employees and other customers that this valuable customer is present. Differentiation of the customer in this manner also enables the casino to provide distinguished services to the customer, such as improved food and beverage services, and slot change or slot fill services. Another example of an enhanced physical instrumentality is the activation of a telephone installed near a gaming machine being used by the customer to allow the valuable customer to make telephone calls without leaving the gaming machine. Yet another example is the activation and enabling of a lockable storage compartment at the gaming machine to allow the customer to store personal items therein, or the automatic unlocking of a door to a privileged facility, such as a VIP club, when the customer's card is recognized and the customer's status or worth suitably determined. *Boushy* 3:8-32.

The mutual incompatibility of the *Boushy* and *Pierce* is such that modification of one by the other would result in an inoperable technique. For example, in *Boushy*, customer status is tracked and updated by a management system associated with a casino, using a LAN and special customer identity cards, and enhanced physical instrumentalities are provided to the customer based on the customer's status while the customer is on the casino premises (i.e., in real time). None of the foregoing features are compatible with *Pierce*. Moreover, at least the following essential features of *Pierce* are incompatible with *Boushy*: matching targeted merchant offers against a data base of consumers and historical purchase behavior, where the value propositions of merchant offers are matched against the consumer data base supplied by the participating card issuers to find eligible consumers, and each consumer receives multiple value propositions from different merchants.

As a result, *Pierce* may not be used to cure the admitted deficiencies in *Boushy*.

Even assuming, arguendo, the combination was proper, the combination still fails to suggest a patron database comprising observed preference data, said observed preference data: (i) representing patron behavior observed in the gaming establishment for at least a first patron of said plurality of patrons for a period of time specified by the operator **and (ii) comprising at**

least one of a gaming preference based on observed time played or actual win or theoretical win and a restaurant preference based on observed restaurant patronage. Nor does the combination suggest a central server evaluating substantially real-time transaction activity of said first patron; and generating a profile for said first patron based at least upon portions of said historical transaction information pertinent to said first patron, said substantially real-time transaction activity, and said observed preference data.

Walker, assuming, arguendo, it may be properly combined with *Boushy* and/or *Pierce*, fails to cure the above-noted deficiencies.

Walker relates to techniques for determining a recipient of an offer; and for determining an offer which includes an activity and a benefit. The techniques further provide for transmitting, to a representative, instructions to provide the offer to the recipient and determining whether the recipient has performed the activity, and if so providing the benefit to the recipient. *Walker*, abstract.

The Office Action asserted that *Walker* discloses a hand-held display having an interface displaying at least one recommendation of an award. Whether or not the assertion is true, such disclosure fails to cure the deficiencies noted above. As a result, claims 1 and 21, and their respective dependent claims, are patentable over the combination of *Boushy*, *Pierce* and *Walker*.

D. Conclusion

The claims are believed to be in condition for allowance. Accordingly, allowance of the claims at the earliest possible date is requested.

If prosecution of this application can be assisted by telephone, the Examiner is requested to call the undersigned attorneys at (510) 663-1100.

Applicants do not believe that any additional fees are required to facilitate the filing of this Amendment. However, if it is determined that such fees are due, please charge such additional fees to Deposit Account No. 504480 (Order No. IGT1P419BX1).

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